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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,943	10/25/2001	Thomas W. Higgs	5087US (20618-US)	2308

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EXAMINER

NINO, ADOLFO

ART UNIT PAPER NUMBER

2831

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,943

Applicant(s)

HIGGS, THOMAS W.

Examiner

Adolfo Nino

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 and 59-63 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-32, 41-44 and 59-63 is/are allowed.
- 6) ☒ Claim(s) 33 and 45 is/are rejected.
- 7) ☒ Claim(s) 34-40 and 46 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayward et al. (US 5,115,260).

Regarding claim 33 (Twice Amended), Hayward et al. disclose a strain control device (10 in fig. 2; col. 2, lines 17-18) comprising: a body (12 in fig. 1; col. 2, lines 19-20) having a first end and a second end (not marked, but clearly seen in figs.); and at least one cavity (24 in figs. 2, 4; col. 2, line 33) formed within a surface of the body between the first end and the second and, the at least one cavity (24) configured to receive at least a portion of a transmission line therein and wherein the at least one cavity defines a deviation path for the at least a portion of the transmission line (col. 1, lines 7-10) such that the at least a portion of the transmission line is enabled to be displaced between the first boundary of the cavity and the second opposing boundary of the cavity upon the elongation and contraction of the body (once the body elongate and contract due to outside forces or change in temperature, a portion of the transmission line is enabled to be displaced between the first boundary of the cavity and the second opposing boundary). **Note** that it has been held that the recitation that an element is "enabled to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re. Hutchinson, 69 USPQ 138.

Regarding claim 45 (Twice Amended), Hayward et al. disclose a strain control device (10) comprising; a body (12) having a first grasping member (not marked, but it would be one of the ends of body 12) configured to frictionally engage a first portion of a transmission line (col. 2, lines 45-48) and a second grasping member (not marked, but it would be one of the ends of body 12) configured to frictionally engage a second portion of the transmission line (col. 2, lines 45-48); and at least one cavity (24) defined in the body between the first grasping member and the second grasping member, the at least one cavity (24) being configured to accommodate a third portion of the transmission line therein and defining a deviation path for the third portion of the transmission line (col. 1, lines 7-10) such that third portion of the transmission line may be displaced between a first boundary of the deviation path and a second opposing boundary of the deviation path upon elongation and contraction of the body (once the body elongate and contract due to outside forces or change in temperature, a portion of the transmission line is enabled to be displaced between the first boundary of the cavity and the second opposing boundary). **Note** that it has been held that the recitation that an element "may" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re. Hutchinson, 69 USPQ 138.

Allowable Subject Matter

Claims 1-32, 41-44, and 59-63 are allowed.

Claims 34-40 and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance:

The primary reason for the indication of the allowability of claims 60 (Twice Amended) and 61 is the inclusion therein of the limitation of "each cavity being at least partially defined by a first wall and a second wall which laterally deviates from the first wall" in combination with the other claim limitations. This limitation is not disclosed nor taught by the prior art, alone or in combination.

The primary reason for the indication of the allowability of claim 62 (New) is the inclusion therein of the limitation of "a second opposing boundary which deviates from the first substantially linear boundary" in combination with the other claim limitations. This limitation is not disclosed nor taught by the prior art, alone or in combination.

The primary reason for the indication of the allowability of claim 63 (New) is the inclusion therein of the limitation of "a second opposing wall which deviates from the first substantially linear wall" in combination with the other claim limitations. This limitation is not disclosed nor taught by the prior art, alone or in combination.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

Applicant's arguments filed December 3, 2002 have been fully considered but they are not persuasive. Please see the "Note" paragraph after the rejections made for claims 33 and 45.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adolfo Nino whose telephone number is (703) 305-1071. The examiner can normally be reached on M-F (7:30-5:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A Reichard can be reached on (703) 308-3682. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

AN
February 24, 2003

Dean A. Reichard 2/24/03
DEAN A. REICHARD
SUPERVISORY PATENT EXAMINER
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